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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,806	06/27/2003	Gail Isabel Reid Adam	11640-008-999	6270

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EXAMINER	
MARTIN, PAUL C	

ART UNIT	PAPER NUMBER
1657	

MAIL DATE	DELIVERY MODE
02/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/607,806	ADAM ET AL.	
	Examiner	Art Unit	
	Paul C. Martin	1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *24-55* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 24-55 are pending in this application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/20/07 has been entered.

However, upon further review of the Application the Examiner deems that further restriction is required.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 24-27, 29-34 and 41, drawn to a method for identifying a candidate therapeutic for fat reduction, comprising contacting a test molecule with a PLA2G1B nucleic acid comprising the nucleotide sequence of SEQ ID NO: 1, classified in class 435, subclass 6 for example.

II. Claims 42-47 and 49-54, drawn to a method for identifying a candidate therapeutic for fat reduction, comprising contacting a test molecule with a PLA2G1B polypeptide comprising the amino acid sequence of SEQ ID NO: 2, classified in class 435, subclass 7.1 for example.

III. Claim 28, drawn to a method of reducing fat deposition in a subject comprising administering a candidate therapeutic to a subject, classified in class 424, subclass 9.2 for example.

IV. Claim 35, drawn to a method of treating NIDDM in a subject comprising administering a candidate therapeutic to a subject, classified in class 424 subclass 9.2 for example.

V. Claim 38, drawn to testing a candidate therapeutic in an animal model of obesity, classified in class 424, subclass 9.1 for example.

VI. Claim 48, drawn to a method for reducing fat deposition in a subject comprising administering a candidate therapeutic to a subject, classified in class 424, subclass 9.2 for example.

VII. Claim 55, drawn to a method for treating NIDDM in a subject comprising administering a candidate therapeutic to a subject, classified in class 424, subclass 9.2 for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to methods that are both physically and functionally distinct such that the particulars of one group are not required for the practice of another. For example, Group I is directed to the method steps of contacting a test molecule with a PLA2G1B *nucleic acid* and detecting an interaction therein, this requirement is not found in any of Groups II-VII which are drawn to screening comprising polypeptides and/or the administration of compounds to subjects.

Inventions II and III-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to methods that are both physically and functionally distinct such that the particulars of one group are not required for the practice of another. For example, Group II is directed to the method steps of contacting a test molecule with a PLA2G1B *polypeptide* and detecting an interaction therein, this requirement is not found in any of Groups III-VII which are drawn to the administration of compounds to subjects.

Inventions III and IV-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to methods that are both physically and functionally distinct such that the particulars of one group are not required for the practice of another. For example, Group III is directed to the administration to a subject of a candidate therapeutic for *reducing fat deposition* putatively identified by its interaction with PLA2G1B *nucleic acid* a requirement not found in any of Groups IV-VII.

Inventions IV and V-VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to methods that are both physically and functionally distinct such that the particulars of one group are not required for the practice of another. For example, Group IV is directed to the administration to a subject of a candidate therapeutic for *treating NIDDM* putatively identified by its interaction with PLA2G1B *nucleic acid* ,a requirement not found in any of Groups IV-VII.

Inventions I and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination of testing a candidate therapeutic in an animal model of obesity does not require the particular test molecule which exhibits an interaction between PLA2G1B *nucleic acid* but may be applied to any compound as a method of screening. The subcombination has separate utility such as toxicity screening of test compounds.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are directed to methods that are both physically and functionally distinct such that the particulars of one group are not required for the practice of another. For example, Group VI is directed to the administration to a subject of a candidate therapeutic for *reducing fat deposition* putatively identified by its interaction with PLA2G1B *polypeptide* a requirement not found in Group VII which requires administering a candidate therapeutic, putatively identified by its interaction with PLA2G1B *polypeptide* for treating NIDDM in a subject.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul C. Martin whose telephone number is 571-272-3348. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul Martin
Examiner
Art Unit 1657

02/05/08

/Jon P Weber/

Supervisory Patent Examiner, Art Unit 1657